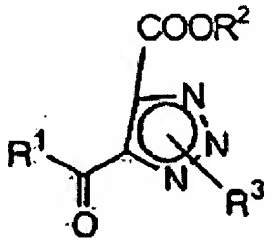
REMARKS

Claims 1-5 are pending in this application.

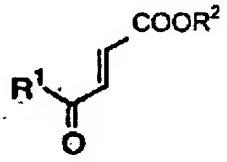
I. Claim Rejections - 35 USC § 102

The Examiner states that "[c]laims 1-5 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ohtsuka, et al (U.S. Pat. No. 7,022,860)."

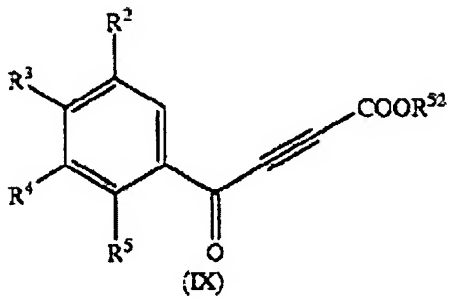
Specifically, the Examiner states that "[a]pplicant's claims relate to a process for producing a 1,2,3-triazole compound

represented by formula (I), 

,said process comprising the step of

reacting a compound represented by formula (II), 

, with an azide compound represented by formula (III), R^3 N_3, in the presence of a transition metal compound. Ohtsuka discloses this process that anticipates the instantly claimed process, wherein said process comprises the step of reacting a compound represented by formula (XI),



(which corresponds to Applicants formula (II),

with an azide compound represented by formula $R^{51}—N_3$ (X), (X) (which corresponds to Applicant's formula (III), in the presence of a transition metal compound, (see '735 Patent [sic], column 15, lines 1-60 and column 14, lines 15-20 discuss the use of a transition metal compound)." Moreover, the Examiner also states that "[i]t should be noted that in both the prior art and the instant application, the transitional phrase comprising is used, which is open ended and could include additional steps not disclosed in the claim."

Applicants respectfully traverse this rejection. Ohtsuka, et al (U.S. Pat. No. 7,022,860) is not a proper reference under 35 U.S.C. 102(b). The international filing date of the present application is February 3, 2003, whereas Ohtsuka, et al (U.S. Pat. No. 7,022,860) issued on April 4, 2006 which is after said international filing date. Thus, it may not be cited as a prior art reference under 35 U.S.C. 102(b). However, applicants respectfully point out that the publication date of WO 99/16770, the corresponding PCT case giving rise to Ohtsuka, et al (U.S. Pat. No. 7,022,860) is April 8, 1999. Thus, WO 99/16770 may be cited by the Examiner as a prior art reference under 35 U.S.C. 102(b). The Examiner is respectfully requested to withdraw Ohtsuka, et al (U.S. Pat. No. 7,022,860) as the prior art reference under 35 U.S.C. 102(b) in this instance, and subsequently replace it with WO 99/16770. Ohtsuka, et al (U.S. Pat. No. 7,022,860) may, however, be a proper reference under 35 U.S.C. 102(e). Applicants also respectfully point out that the Examiner may inadvertently have made typographical error in the aforementioned rejection by referring to Ohtsuka, et al (U.S. Pat. No. 7,022,860) as "the '735 patent" instead of the correct abbreviated form which is "the '860 patent."

Applicants further point out that the reaction cited by the Examiner in column 14, lines 15-20 of Ohtsuka, et al (U.S. Pat. No. 7,022,860, and correspondingly, WO 99/16770, hereinafter referred to as "the '860 patent") in which a compound represented by formula (IIa) is reduced to form the compound represented by formula (IIb) which is

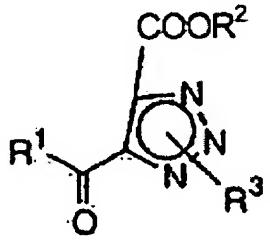
subsequently cyclicized, is not the reaction of the present application. The reaction cited by the Examiner merely reduces one triazole compound (formula (IIa)) to another triazole compound (formula (IIb)). Moreover, the reaction of the compound represented by formula (XI) with the compound represented by formula (X) as taught in the '860 patent, columns 15-16, lines 1-60 and column 21, lines 39-46 does not teach the use of a transition metal compound, an essential element of claims 1-5 of the present application. The Examiner arrives at this 35 USC § 102(b) rejection by selectively reading the prior art; that is by picking and choosing elements from different parts of the reference and by combining them. This type of analysis is improper. See *In re Kamm*, 452 F.2d 1052, 1056-57, 172 USPQ 298, 301-02 (CCPA 1972) ("It is not proper to dissect claims and reconstruct them in piecemeal fashion by picking and choosing from among the prior art references using the patent as a blueprint.").

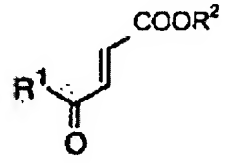
Additionally, Applicants are confused about the Examiner's reliance upon the "comprising" language in the claims. The transition metal compound recited in claim 1 of the present application is a necessary element of the claim. The open ended "comprising" language doesn't change this fact. It merely permits additional elements. The term "comprising," while permitting additional elements not required by a claim, does not remove the limitations that are present. See *W.E. Hall v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1353 (Fed. Cir. 2004). In equating the cited prior art - which does not teach the transition metal compound - with the present application, the Examiner removes a necessary element and a limitation of claim 1 of the present application. This the Examiner cannot do.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As such, the '860 patent cannot serve as the basis of a 35 U.S.C. 102(b) rejection. Applicants assert that the present anticipation rejection is improper and respectfully request its withdrawal.

II. Claim Rejections - 35 USC § 103

The Examiner states that "[c]laims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka et al., U.S. Pat. No. 5,840,895 ('895 Patent) (1998); U.S. Pat. No. 6,093,714 ('714 Patent) (2000); and U.S. Pat. No. 6,372,735 ('735 Patent)."

Specifically, the Examiner states that "[c]laims 1-5 of Applicant's instant elected invention teaches a process for producing a 1,2,3-triazole compound represented by formula (I),  , said process comprising the step of reacting a compound represented by formula (II),



, with an azide compound represented by formula (III), R^3 N_3, in the presence of a transition metal compounds."

In applying the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in which the Examiner attempts to (i) determine of the scope and content of the prior art (MPEP § *2141.01)*; (ii) ascertain the differences between the prior art and the claims at issue; and (iii) resolve the level of ordinary skill in the pertinent art, the Examiner states the following respectively:

(i) "Ohtsuka teaches a process for preparing a compound of formula (III) . . . , which corresponds to Applicants formula (I) . . . , said process comprising the step of reacting a compound represented by formula (VII) . . . ,with an azide compound represented by formula (VIII), **"R---N_3 (VIII)** ; in the presence of a transition metal compound, (see

'714 Patent, column 10, reaction scheme, lines 38-70 and '895 Patent, column 20, Reaction Scheme (A), lines 1-70)[.];"

(ii) "The difference between the prior art of Ohtsuka and the instant claims is that the prior art uses an alcohol, while the instant application uses a carbonyl group in the starting product. In the instant application, the oxidation process occurs before the addition of the azide, while in the prior art the oxidation of the alcohol occurs in a later step to obtain the same product[.];" and

(iii) "One skilled in the art would have found the claimed process prima facie obvious because the instantly claimed process and the process in Ohtsuka only differ in the order, i.e. the timing of the oxidation step." The Examiner further states that "[i]n addition, the instantly claimed process uses the transition phrase "comprising" which is open-ended and does not exclude additional, unrecited elements or method steps . . .," ". . . that it is well established that changes in order of the reaction, minor changes in reaction conditions, are not patentable in the absence of unexpected results, which is different in kind and not degree . . .," that "discovery of an optimum value of a result effective variable is not patentable if such discovery is within skill in the art . . .," and that "[a] prima facie case of obviousness may be rebutted in optimizing a variable only when results are unexpectedly good." The Examiner, thus, concludes that "the claimed process is prima facie obvious in light of the prior art unless applicant can show that oxidizing the alcohol at a later time yields *unexpectedly* good results and one skilled in the art may assume that since the products of the processes are the same that the enhancements made to the process in the instant application, would share the same properties as the prior art of Ohtsuka[.];"

Applicants respectfully traverse this rejection. Applicants point out to the Examiner that as the '735 patent is the parent case of the '860 patent, both share the same disclosure as the '860 patent. Moreover, the '714 patent refers to the reaction process (A) as taught by WO 95/18130, which is the basis for the '895 patent. As such

any obviousness rejection based on a combination of the aforementioned references should be based on the '860 patent in view of the '895 patent.

A rejection under 35 USC § 103 based upon a combination of art must provide a motivation for combining such art and also provide an expectation of success in arriving at the invention through such combination. Here, one could not arrive at the present invention through the above combination because, contrary to the Examiner's assertions, none of the cited reference teach or suggest the use of the reaction between an olefin compound (formula (II) of the present application) with an azide compound (formula (III) of the present application) in the presence of a transition metal compound. It is only the applicants' specification that provides such a teaching. Moreover, as stated earlier, the traditional phrase "comprising" as used both in the present application and in the '860 patent represents the possible inclusion of additional steps, and does not eliminate elements within a recited step. Thus, Applicants assert that the present obviousness rejection is improper and respectfully request its withdrawal.

III. Claim Rejections - 35 USC §112, 2nd paragraph

The Examiner states that "[c]laim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner, Claim 1 is indefinite because the term "comprising" is open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03."

Applicants vigorously traverse this rejection. The claims are clear and concise: the invention is a reaction step between formula (I) and formula (II) of the present application in the presence of a transition metal compound. "Comprising" means that the claims must have the recited elements but do not exclude additional steps. Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

IV. Claim Objections

The Examiner states that "[t]he Claims are objected to because of the following informalities: the heading of the claims reads a different docket number, serial number, and applicant. Applicants believe this objection is now moot.

CONCLUSION

In light of the above comments, Applicants respectfully request that all rejections and objections be withdrawn and that a timely Notice of Allowance should be issued in this application. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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